



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
|-----------------|-------------|----------------------|---------------------|------------------|

10/665,029

09/16/2003

William Waycott

20612.002/P30632US01

4492

28381 7590 09/04/2008

ARNOLD & PORTER LLP  
ATTN: IP DOCKETING DEPT.  
555 TWELFTH STREET, N.W.  
WASHINGTON, DC 20004-1206

EXAMINER

ROBINSON, KEITH O NEAL

ART UNIT

PAPER NUMBER

1638

MAIL DATE

DELIVERY MODE

09/04/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

|                              |                                      |   |  |
|------------------------------|--------------------------------------|---|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/665,029 | <b>Applicant(s)</b><br>WAYCOTT, WILLIAM |  |
|                              | <b>Examiner</b><br>KEITH O. ROBINSON | <b>Art Unit</b><br>1638                 |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 23 June 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,2,5-9 and 38-70 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,5-9,46-48 and 51-70 is/are rejected.
- 7) ☒ Claim(s) 38-45, 49 and 50 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action. Applicant's amendment of claims 1, 2, 5-8, 38, 40-43, 45, 46, 48 and 50, cancellation of claims 3, 4 and 10-37 and addition of new claims 57-70, filed June 23, 2008, have been received and entered in full.

2. Claims 1, 2, 5-9 and 38-70 are under examination.

### ***Response to Arguments***

#### ***Claim Rejections - 35 USC § 112, first paragraph – Written Description***

3. Claims 1, 2, 5-9, 46-48 and 51-56 remain rejected and new claims 57-70 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The rejection is repeated for the reasons of record as set forth on pages 2-5 of the Office Action mailed January 23, 2008, as applied to claims 1, 2, 5-9, 46-48 and 51-56. Applicant's arguments, filed June 23, 2008, have been fully considered but are not persuasive.

Applicant argues that the specification reflects Applicant's possession of the claimed invention because Applicant has provided sufficient structural characteristics that distinguish the members of the genus and that Applicant has provided several exemplary lines (see page 9, 2nd paragraph of 'Remarks' filed June 23, 2008).

Art Unit: 1638

This is not persuasive. The structural characteristics claimed by Applicant, i.e., elliptical stature, first outer leaf having a length to width ratio between about 1.2 to about 2.7 and a color range from about RHS 146A to about RHS 146B) does not distinguish claimed invention from other lettuce plants having the same structural characteristics. A person skilled in the art would, after reading the present specification, would understand that Appellant had possession of lettuce breeding lines PSR 4569, PSR 4570, PSR 6425, PSR 6595 and PSR 6032.

Applicant is in possession of a narrow invention limited to particular deposited lines; however, they are broadly claiming every iceberg lettuce plant that has the claimed phenotype. This is paramount to selecting a seed line for high yield and then claiming every seed line that has high yield, regardless of how they are made. It would be like selecting a seed line for its color and then claiming every seed that happens to have that characteristic regardless of how it was derived.

Applicant argues that the Examiner has not provided sufficient evidence or reasoning why the written description present in the specification is insufficient (see page 10, 1st paragraph of 'Remarks' filed June 23, 2008).

This is not persuasive. The claims are not drawn to the written description in the specification, i.e., lettuce breeding lines PSR 4569, PSR 4570, PSR 6425, PSR 6595 and PSR 6032. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Applicant argues that a basis for why the written description is required for the public policy of warning an innocent purchaser is not provided and that a skilled artisan is able to use a ruler to measure the leaves or use a color chart to determine color (see page 10, 2<sup>nd</sup> paragraph of 'Remarks' filed June 23, 2008).

This is not persuasive. As stated above, Applicant is in possession of a narrow invention limited to particular deposited lines; however, they are broadly claiming every iceberg lettuce plant that has the claimed phenotype. Applicant seems to be under the impression that they are entitled to all iceberg lettuce cultivars having the claimed characteristics, even those derived from other inventors using other methods. For it is widely known in the art that different cultivars can exhibit similar phenotypes though they are produced by different methods and use different starting materials.

The Examiner agrees that a skilled artisan can use a ruler to measure leaves of lettuce cultivars; however, is Applicant entitled to every iceberg lettuce cultivar that comprises a first outer leaf having a length to width ratio between about 1.2 to about 2.7 when the instant specification only provides evidence that Applicant was in possession of lettuce breeding lines PSR 4569, PSR 4570, PSR 6425, PSR 6595 and PSR 6032?

In addition, is Applicant entitled to every iceberg lettuce cultivar that has a color range from about RHS 146A to about RHS 146B when the instant specification only provides evidence that Applicant was in possession of lettuce breeding lines PSR 4569, PSR 4570, PSR 6425, PSR 6595 and PSR 6032?

Furthermore, though the Examiner agrees that one skilled in the art can use a color chart to determine color, it is unclear if one skilled in the art would know how to

Art Unit: 1638

use the cited chart to determine a color range from about RHS 146A to about RHS 146B. The specification teaches that RHS 146A is dark green and RHS 146B is green (see, for example, page 9, paragraph 00045 to page 10, lines 1-2); however, it is not clear what color constitutes from about RHS 146A to about RHS 146B.

The lettuce breeding lines PSR 4569, PSR 4570, PSR 6425, PSR 6595 and PSR 6032 as taught in the specification would warn an innocent purchaser of his infringement of the patent because these lines have specific morphological, genetic and physiological characteristics unique to those specific lines. In addition, the specification provides evidence that Applicant was in possession of lettuce breeding lines PSR 4569, PSR 4570, PSR 6425, PSR 6595 and PSR 6032.

Applicant argues that the Examiner may be attempting to limit Applicant's claims to the exemplified embodiment (see page 10, last paragraph of 'Remarks' filed June 23, 2008).

This is not persuasive. MPEP 2163(I) where it states "[t]o satisfy the written description requirement, a patent specification must describe the claimed invention in sufficient detail that one skilled in the art can reasonably conclude that the inventor had possession of the claimed invention. In the instant case, Applicant the instant specification describes the claimed invention in sufficient detail that one skilled in the art would reasonably conclude that Applicant had possession of lettuce breeding lines PSR 4569, PSR 4570, PSR 6425, PSR 6595 and PSR 6032.

Applicant argues that there is an apparent contradiction between the Examiner's assertions because the Examiner has repeatedly stated that Applicant has possession of breeding lines and that this acknowledgement contradicts the Examiner's position that those lines could not be bred to produce other lettuce plants with the claimed characteristics (see page 11, 1<sup>st</sup> paragraph of 'Remarks' filed June 23, 2008).

This is not persuasive. The Examiner uses the term breeding lines because that is what is used in Applicant's specification (see, for example, page 14, Example 2). Thus, it is unclear what the apparent contradiction is concerning the Examiner's assertions.

***Claim Rejections - 35 USC § 112, first paragraph - Enablement***

4. Claims 1, 2, 5-9, 46-48 and 51-56 remain rejected and new claims 57-70 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for lettuce breeding lines PSR 4569, PSR 4570, PSR 6425, PSR 6595 and PSR 6032, does not reasonably provide enablement for all iceberg lettuce cultivars having an elliptical stature and comprising a first outer leaf having a length to width ratio between 1.2 to about 2.7 and a color which ranges from about RHS 146A to about RHS 146B. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention commensurate in scope with these claims. The rejection is repeated for the reasons of record as set forth on pages 5-8 of the Office Action mailed January 23, 2008, as

Art Unit: 1638

applied to claims 1, 2, 5-9, 46-48 and 51-56. Applicant's arguments, filed June 23, 2008, have been fully considered but are not persuasive.

Applicant argues that the Examiner's argument that the specification is not enabled for more than lettuce lines PSR 4569, PSR 4570, PSR 6425, PSR 6595 and PSR 6032 is erroneous and the Examiner tries to find support for his position by selectively quoting the specification out of context (see page 11, last paragraph to page 12, lines 1-4 of 'Remarks' filed June 23, 2008).

This is not persuasive. The specification only provides guidance for how to make and use lettuce breeding lines PSR 4569, PSR 4570, PSR 6425, PSR 6595 and PSR 6032.

Applicant argues that they managed to combine the genes necessary for the claimed traits in individual lettuce lines and provide deposits of seed for those lines; thus it is possible to breed other lettuce plants with the claimed characteristics and the Examiner has acknowledged that the deposited lines are breeding lines (see page 12, 1<sup>st</sup> paragraph of 'Remarks' filed June 23, 2008).

This is not persuasive. The rejected claims are not drawn to individual lettuce lines nor do the claims recite any deposit information. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).



Art Unit: 1638

As stated above, the Examiner uses the term breeding lines because this term is used in the specification.

Applicant argues that a specification that discloses how to use a claimed invention must be taken as in compliance with the enabling requirement unless there is reason to doubt the objective truth of the statements contained therein and further argues that the Examiner does not provide evidence to support the rejection or even an adequate explanation why the specification fails the enablement requirement (see page 12, last paragraph to page 13, 1st paragraph of 'Remarks' filed June 23, 2008).

This is not persuasive. The basis of the rejection is that the specification teaches how to make and use lettuce lines PSR 4569, PSR 4570, PSR 6425, PSR 6595 and PSR 6032; however, the claims are broadly drawn to any iceberg lettuce cultivars having an elliptical stature and comprising a first outer leaf having a length to width ratio between 1.2 to about 2.7 and a color which ranges from about RHS 146A to about RHS 146B. Thus, Applicant is enabled for lettuce lines PSR 4569, PSR 4570, PSR 6425, PSR 6595 and PSR 6032.

Applicant argues that the Examiner's comments are not clear and it appears that the Examiner is speculating that one could not use PSR 6425, PSR6595 or PSR 6032 as a breeding parent and that speculation is not a basis to challenge enablement (see page 13, 1<sup>st</sup> paragraph of 'Remarks' filed June 23, 2008).

Art Unit: 1638

This is not persuasive. The above cited lines are not claimed in the rejected claim. As stated above, the basis of the rejection is that the specification teaches how to make and use lettuce lines PSR 4569, PSR 4570, PSR 6425, PSR 6595 and PSR 6032; however, the claims are broadly drawn to any iceberg lettuce cultivars having an elliptical stature and comprising a first outer leaf having a length to width ratio between 1.2 to about 2.7 and a color which ranges from about RHS 146A to about RHS 146B. Thus, Applicant is enabled for lettuce lines PSR 4569, PSR 4570, PSR 6425, PSR 6595 and PSR 6032.

Applicant argues that the Examiner has not made clear why one would have to separate the deposited seeds and request that the Examiner provide a basis for asserting that a mixed seed deposit is not enabling (see page 13, 3rd and 4th paragraph of 'Remarks' filed June 23, 2008).

Applicant's deposit of *Lactuca sativa* lines PSR 6425, PSR 6595 and PSR 6032 under accession number PTA-3248) is not enabling because though it would be possible to distinguish PSR 6032 from PSR 6425 and PSR 6595 based on the fact that PSR 6032 has black seed color and the other two have white seed color, it would not be possible to distinguish PSR 6425 from PSR 6595 because both have white seed color. Thus, a separate deposit would be required to use the claimed lettuce lines.

***Claim Rejections - 35 USC § 103***

Art Unit: 1638

5. Claims 1, 2, 5-7, 46-48 and 51-56 remain rejected and new claims 57-70 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miltz (US Patent No. 5,220,113, June 15, 1993), in view of Tillge (Seed Sci. & Technol. 12: 919-933, 1984), further in view of Bassett (J. Amer. Soc. Hort. Sci. 100(2): 104-105, 1975). The rejection is repeated for the reasons of record as set forth on pages 9-11 of the Office Action mailed January 23, 2008, as applied to claims 1, 2, 5-7, 46-48 and 51-56. Applicant's arguments, filed June 23, 2008, have been fully considered and are not persuasive.

Applicant argues that the premise underlying the rejection is erroneous and Applicant also set forth in the previous response why Tillge and Bassett cannot make up for the deficiencies of the admitted deficiency of the Miltz reference (see page 14, 2<sup>nd</sup> paragraph of 'Remarks' filed June 23, 2008).

This is not persuasive. It would be obvious to one of ordinary skill in the art to combine the cited references because Miltz teaches an iceberg lettuce cultivar, namely 'BUD 71-3', having a length to width ratio between about 1.2 to about 2.7, namely 1.5, and a color range from about RHS 146A to about RHS 146B, namely RHS 146B (see column 4, line 52 to column 5, line 4), a blanched inner leaf color, ranging from about RHS 145C to about RHS 145D (see column 1, line 53, wherein "creamy colored interiors" is interpreted as a color between RHS 145C (pale green) to about RHS 145D (white or blanched), as defined on page 2, paragraph 0006 of the specification), and resistance to corky root rot (see column 5, lines 42-44).

Art Unit: 1638

Tillge teaches that there is variation in lettuce morphology and that lettuce cultivars can have different morphological characteristics such as leaf color, leaf shape, etc. For example, Tillge teaches elliptical leaf shape (see pages 922 and 929). Thus, one of ordinary skill in the art would understand that various leaf shapes and statures could be produced by crossing lettuce varieties with desired traits.

Bassett teaches lettuce having an open rosette, which is interpreted as a semi-open head (see page 104, 1<sup>st</sup> column, 4<sup>th</sup> paragraph). In addition, Bassett teaches that there is variation in lettuce length to width ratio and that heading types vary greatly depending upon the parental lines used in the cross and are genetically controlled (see page 105, Table 3, page 104, 1<sup>st</sup> column, 1<sup>st</sup> paragraph and page 104, 1<sup>st</sup> column, 3<sup>rd</sup> paragraph, respectively). Thus, one of ordinary skill in the art would understand that various head types and lettuce length to width ratios could be produced by crossing lettuce varieties with desired traits.

Thus, it would have been *prima facie* obvious to one of ordinary skill in the art at the time of Applicant's invention to combine the above teachings to produce the claimed invention because one of ordinary skill in the art would understand how to cross different lettuce varieties to produce lettuce cultivars with desired traits.

One of ordinary skill in the art would have been motivated to combine these teachings because Miltz teaches, "[l]ettuce...is a commercially important...crop...widely grown throughout the temperate and subtropical regions of the world, and is used predominately as a fresh green in the human diet" (see page column 1, lines 10-16) and Bassett teaches, "the large role L.I. [length to width ratio] plays in head formation may

Art Unit: 1638

be useful in practical lettuce breeding...[s]electing on the basis of L.I. may be more effective than selection on the basis of overall appearance.

In addition, one of ordinary skill in the art would have reasonable expectation of success based on the success of Miltz in producing an iceberg lettuce cultivar having a length to width ratio between about 1.2 to about 2.7 and a color range from about RHS 146A to about RHS 146B and resistance to corky root rot, coupled with the teaching of Tillge's teachings of variation in lettuce morphology and the teachings of Bassett of variation in lettuce length to width ratio and the genetic control of lettuce head formation.

Applicant argues that the premise underlying the Examiner's rejection, that a plant with an open rosette can be interpreted as a plant with a semi-open head, is inconsistent with terminology as used and defined in the specification and the art (see page 14, 3<sup>rd</sup> paragraph of 'Remarks' filed June 23, 2008).

This is not persuasive. The premise of the rejection is not that a plant with an open rosette can be interpreted as a plant with a semi-open head, as Applicant has incorrectly stated. That rejection is in reference to the Bassett reference.

The premise of the rejection is the Miltz reference which teaches an iceberg lettuce cultivar, namely 'BUD 71-3', having a length to width ratio between about 1.2 to about 2.7, namely 1.5, and a color range from about RHS 146A to about RHS 146B, namely RHS 146B (see column 4, line 52 to column 5, line 4), a blanched inner leaf color, ranging from about RHS 145C to about RHS 145D (see column 1, line 53, wherein "creamy colored interiors" is interpreted as a color between RHS 145C (pale

Art Unit: 1638

green) to about RHS 145D (white or blanched), as defined on page 2, paragraph 0006 of the specification), and resistance to corky root rot (see column 5, lines 42-44).

Applicant argues that the Bassett reference is not enabling and that it never produces a heading lettuce that has the claimed leaf proportions (see page 14, last paragraph to page 15, lines 1-2 of 'Remarks' filed June 23, 2008).

This is not persuasive. The Bassett reference was not used to cite the claimed leaf proportions. The primary reference, Miltz teaches the claimed leaf proportions as stated above.

Applicant argues that the Bassett reference teaches away from the claimed invention (see page 15, 1<sup>st</sup> and 2<sup>nd</sup> paragraphs of 'Remarks' filed June 23, 2008).

This is not persuasive. As stated above, the Miltz reference teaches an iceberg lettuce cultivar having a length to width ratio between about 1.2 to about 2.7 and a color range from about RHS 146A to about RHS 146B. The Bassett reference was not used to teach the claimed characteristics, but was instead used as a secondary reference against dependent claims.

In response to Applicant's arguments against the Bassett reference, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In the instant case, it is the combination of references that make the claimed invention obvious to one of ordinary skill in the art.

***Conclusion***

6. 1, 2, 5-9, 46-48 and 51-70 are rejected.
7. Claims 38-45, 49 and 50 are objected to as being depended upon rejected claims.
8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

***Contact Information***

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to KEITH O. ROBINSON whose telephone number is (571)272-2918. The examiner can normally be reached Monday – Friday, 7:30 a.m. - 4:30 p.m. EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anne Marie Grunberg can be reached at (571) 272-0975. The fax phone

Art Unit: 1638

number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Keith O. Robinson, Ph.D.

Examiner

Art Unit 1638

/David H Kruse/

Primary Examiner, Art Unit 1638

August 27, 2008